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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD ST. CLAIR BAILEY and STEPHEN R. FALCON

Appeal 2008-0544
Application 09/638,658
Technology Center 2100

Decided: August 29, 2008

Before HOWARD B. BLANKENSHIP, JAY P. LUCAS, and ST. JOHN
COURTENAY III, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-27, which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse, and enter new grounds of rejection as permitted by 37 C.F.R. § 41.50(b).

Appellants claim methods and apparatus for allowing a gradual visual correction between a user's input and a selected object within a graphical user interface (GUI) environment. (Abstract.) Claims 1, 16, and 17 are illustrative.

1. A method comprising in a graphical user interface:

determining an offset value between a selected object's position and an input position;

and

dynamically and gradually reducing the offset value by correctively adjusting the input position with respect to the object's position in proportion to a movement of the selected object.

16. A computer-readable medium having computer-executable instructions for causing at least one processing unit to perform acts comprising:

determining an offset value between a selected object's position and an input position;

and

dynamically and gradually reducing the offset value using a corrective function that selectively and incrementally reduces the offset in proportion to a movement of the selected object.

17. An apparatus comprising logic configured to determine an offset value between a selected object's position and an input position, and dynamically and gradually reduce the offset value by correctively adjusting the input position with respect to the object's position in proportion to a movement of the selected object.

The Examiner relies on the following references as evidence of unpatentability.

Leah	US 5,808,601	Sep. 15, 1998
Shieh	US 5,870,083	Feb. 9, 1999
Rosenberg	US 6,894,678 B2	May 17, 2005

(effective filing date Aug. 23, 1997)

Claims 1-25 and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Leah and Rosenberg.

Claim 26 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Leah, Rosenberg, and Shieh.

I. The standing rejections

In the rejection of claim 1 over Leah and Rosenberg, the Examiner contends that Leah teaches determining an offset value between a selected object's position and an input position, and dynamically and gradually reducing the offset value by correctively adjusting the input position with respect to the object's position. The rejection refers to Leah at Figures 1, 2C, and column 6, lines 16 through 44 of the reference. (Ans. 3.)

Unfortunately, the statement of rejection leaves one to speculate what in Leah might be deemed a "selected object" and what might be deemed an "input position." However, the Answer later indicates (at 8 and 9) that the "selected object" is deemed to be taught by the "cursor" described by Leah; presumably, the "displayed mouse pointer" 4 depicted in Figures 2A through 2C of the reference, because the "real physical mouse pointer position" 5 has no visual representation. See Leah col. 6, ll. 16-44.

Leah describes, in columns 5 and 6, a push button 1 (Figs. 2A-2C) assigned an imaginary mass “m.” “Real mouse” pointer 5 is assigned a mass value “M.” When the real mouse pointer 5 enters the “gravitational” boundary 3 of push button 1 (Fig. 2B), the visually displayed portion of the virtual mouse 4 is moved at once to the hot or selectable portion of object (push button) 1 (Fig. 2C). The physical location of the actual mouse pointer 5 does not change so far as the user is concerned, but on the screen the virtual mouse pointer 4 has become “attracted to,” and positioned directly on, the “selectable object” 1.

The “selectable object” or push button 1 does not move in the described scenario. Push button 1 thus cannot teach the “input position” of instant claim 1. Physical mouse pointer position 5 may be properly considered an “input position.” By that reading, however, Leah teaches in Figure 2C the opposite of what is claimed -- an “offset value” between the displayed pointer and the real mouse pointer position is increased, rather than reduced. Moreover, the “input position” 5 is not “correctively adjusted” with respect to the object’s (1) position.

The rejection of claim 1 relies on Rosenberg for a teaching of “in proportion to a movement of the selected object.” (Ans. 3.) However, such a teaching does not remedy the deficiencies in Leah as applied against claim 1.

In the rejection of claim 16, the Answer (6) refers to the rejection of claim 8 and to material in Leah that we have discussed. The rejection of claim 8 (Ans. 5), and thus claim 16, is more specific than that applied against claim 1 in correlating the claimed “input position” with real mouse

pointer position 5 in Leah. Claim 16 requires, however, reducing the offset value between a selected object's position and an input position. In the Examiner's reading of claim 16 on the elements of Leah, the reference teaches, in essence, the opposite of what is claimed.

Claims 1 and 16 are representative of the independent claims on appeal. Because neither Rosenberg nor Shieh remedy the deficiencies in Leah as applied against the claims, we agree with Appellants to the extent that the rejections fail to demonstrate prima facie obviousness of the claimed subject matter. We do not sustain the § 103(a) rejection of claims 1-27.

II. New ground of rejection -- § 112, first paragraph, written description

Claims 1-7, 10-15, 17-22, and 24-27 are rejected under 35 U.S.C. § 112, first paragraph, for lack of written description support for the claimed subject matter.

To comply with the "written description" requirement of 35 U.S.C. § 112, first paragraph, an applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention is, for purposes of the "written description" inquiry, whatever is now claimed. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991). To "convey with reasonable clarity to those skilled in the art" may also be expressed in terms of whether the "necessary and only reasonable construction" to be given the disclosure by one skilled in the art clearly supports the limitation now claimed. *See Hyatt v. Boone*, 146 F.3d 1348, 1354 (Fed. Cir. 1998) ("We do not view

these various expressions as setting divergent standards for compliance with § 112. In all cases, the purpose of the description requirement is ‘to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him.’”) (quoting *In re Edwards*, 568 F.2d 1349, 1351-52 (CCPA 1978)).

The invention claimed does not have to be described in *ipsis verbis* in order to satisfy the written description requirement. *Union Oil Co. v. Atlantic Richfield Co.*, 208 F.3d 989, 1000 (Fed. Cir. 2000). However, one skilled in the art, reading the original disclosure, must be able to immediately discern the limitations now claimed. *See Waldemar Link GmbH & Co. v. Osteonics Corp.*, 32 F.3d 556, 558 (Fed. Cir. 1994) (“The fact finder must determine if one skilled in the art, reading the original specification, would immediately discern the limitation at issue in the parent.”).

We are mindful, however, that the question of written description support should not be confused with the question of what would have been obvious to the artisan. Whether one skilled in the art would find the instantly claimed invention obvious in view of the disclosure is not an issue in the “written description” inquiry. *In re Barker*, 559 F.2d 588, 593 (CCPA 1977). A description which renders obvious the invention for which the benefit of an earlier date is sought is not sufficient. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997).

When a claimed limitation is not present in the written description, it must be shown that a person of ordinary skill would have understood, at the time the application was filed, that the description requires that limitation.

See Hyatt v. Boone, 146 F.3d at 1353 (“[W]hen an explicit limitation in an interference count is not present in the written description whose benefit is sought it must be shown that a person of ordinary skill would have understood, at the time the patent application was filed, that the description requires that limitation.”).

One shows “possession” by descriptive means such as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood*, 107 F.3d at 1572. It is not sufficient for purposes of the written description requirement that the disclosure, when combined with the knowledge in the art, would lead one to speculate as to modifications that the inventor might have envisioned, but failed to disclose. *Id.*

In Appellants’ disclosed invention, Figure 3 depicts exemplary GUI object 110’ as a slider control switch in a touch screen interface. The object includes a thumb 260 that is graphically modeled as sliding along a channel 262 in a linear path 264. (Spec. 9: 1-5.) A preferred contact area 266, associated with thumb 260, represents a visually appealing area on thumb 260, which is the area of thumb 260 that designers prefer to be “grabbed” by the user. (*Id.*, ll. 11-18.)

If an offset exists between a user’s input and an object’s preferred contact area 266, as the user moves GUI object 110 (Fig. 1) within GUI environment 108, the magnitude of the offset is “selectively and incrementally” altered over time and distance in a manner that is “nearly imperceptible to the user.” The corrective process is continued until the latest positioning information significantly matches the preferred contact

area 266, falls within a defined tolerance thereof, or the user stops providing new positioning information. (Spec. 10: 8-14.)

Figures 4(a) through 4(c) depict thumb 260 at various times while the user is moving thumb 260 towards the right hand side of the page, with correction of the misplacement defined by the offset in the x direction. The offset between positioning information or touch point 270 and preferred contact area 266 is reduced to zero (Fig. 4(c)). Correction of the offset may be accomplished by using a corrective factor that effectively causes the movement of thumb 260 in the increasing x-direction to be slower than that of positioning information 270. (Spec. 10: 17 - 11: 13.) The corrective factor, for example, may cause the offset to be reduced by 1 pixel for every four pixels of movement in positioning data 270. Thus, for every five pixels of movement of positioning data 270 in the positive x direction, thumb 260 will be moved 4 pixels in the same direction until such time as the offset is zero, falls below a defined threshold, or the user stops inputting data. (Spec. 11: 14-19.)

Instant claim 1 recites determining an offset value between a selected object's position and input position, and "dynamically and gradually" reducing the offset value *by correctively adjusting the input position with respect to the object's position* in proportion to a movement of the selected object. In the terms of claim 1, Appellants disclosed determining an offset value between a selected object's position (260 or 266; Fig. 4(a)) and an input position 270. Appellants described "dynamically and gradually" reducing the offset value *by correctively adjusting the object's position with respect to the input position*. Appellants did not disclose, however, the

invention of claim 1. In Appellants' invention as disclosed, the input position is determined by a user's interaction with the interface, not something "correctively adjusted" in proportion to a movement of the selected object.

Independent claims 10 and 17 contain language similar to that of claim 1 that defines an invention not described by Appellants' disclosure. In view of the claims depending from those independent claims, we reject claims 1-7, 10-15, 17-22, and 24-27.

III. New ground of rejection -- § 101, nonstatutory subject matter

Claims 17-19, 21, and 22 are rejected under 35 U.S.C. § 101 as being directed to nonstatutory subject matter.

"The four categories [of § 101] together describe the exclusive reach of patentable subject matter. If a claim covers material not found in any of the four statutory categories, that claim falls outside the plainly expressed scope of § 101 even if the subject matter is otherwise new and useful." *In re Nuijten*, 500 F.3d 1346, 1354 (Fed. Cir. 2007).

Base claim 17 may be read, under a broad but reasonable interpretation, as reciting "logic" in the abstract, such as a computer program that is not tied to a particular machine -- computer software *per se* or a computer listing *per se*. Cf. *Manual of Patent Examining Procedure* § 2106.01, heading I (8th ed., Rev. 6, Sept. 2007) ("USPTO personnel should treat a claim for a computer program, without the computer-readable medium needed to realize the computer program's functionality, as nonstatutory functional descriptive material."). The "logic" as claimed

represents no more than an abstract idea. As the Supreme Court has made clear, “[a]n idea of itself is not patentable.” *In re Warmerdam*, 33 F.3d 1354, 1360 (quoting *Rubber-Tip Pencil Co. v. Howard*, 87 U.S. (20 Wall.) 498, 507, 22 L.Ed. 410 (1874)).

We acknowledge that claim 17 purports an “apparatus.” However, no “apparatus” structure is set forth in the claim. Drafting the claim to be nominally directed to an “apparatus” is not sufficient, in our view, to place the subject matter within a statutory class. Calling the “logic” an “apparatus” does not limit the subject matter to a statutory class such as machine or manufacture. To conclude otherwise would exalt form over substance.

Depending claims 18, 19, 21, and 22 add nothing of substance to the subject matter of base claim 17. We therefore enter the § 101 rejection against claims 17, 18, 19, 21, and 22.

IV. New ground of rejection -- § 112, first paragraph, lack of enablement

Claims 17-19, 21, and 22 are rejected under 35 U.S.C. § 112, first paragraph, as lacking enabling disclosure.

Base claim 17 recites logic “configured” to do recited functions. An invention may be defined entirely by its functions, but only when elements are claimed in combination. *See* 35 U.S.C. § 112, sixth paragraph (“An element in a claim *for a combination* may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the

corresponding structure, material, or acts described in the specification and equivalents thereof.”) (emphasis added).¹

Claim 17 does not appear to be in “means plus function” format. Even if the claim were to be interpreted in accordance with § 112, sixth paragraph, the claim would still not pass muster under § 112, first paragraph because of the single “logic” means. *See In re Hyatt*, 708 F.2d 712, 714 (Fed. Cir. 1983) (“single means” claims are properly rejected under the first paragraph of § 112).

Dependent claims 18, 19, 21, and 22, at most, merely further refine the functions or characteristics of the “logic.” Since the claims cover every conceivable means for achieving the recited results, we enter the new ground of rejection under § 112, first paragraph against claims 17-19, 21, and 22.

CONCLUSION

The rejection of claims 1-25 and 27 under 35 U.S.C. § 103(a) as being unpatentable over Leah and Rosenberg is reversed.

The rejection of claim 26 under 35 U.S.C. § 103(a) as being unpatentable over Leah, Rosenberg, and Shieh is reversed.

In a new ground of rejection, we reject claims 1-7, 10-15, 17-22, and 24-27 under 35 U.S.C. § 112, first paragraph, for lack of written description

¹ Congress enacted § 112, ¶ 6, in response to *Halliburton Oil Well Cementing Co. v. Walker*, 329 U.S. 1 (1946). *Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 27-28 (1997). Section 112, ¶ 6, now expressly allows “means” claims, with the proviso that application of the broad literal language of such claims must be limited to only those means that are equivalent to the actual means shown in the patent specification. *Id.* at 28.

support for the claimed subject matter. We reject claims 17-19, 21, and 22 on the further grounds of § 101 as being directed to nonstatutory subject matter and § 112, first paragraph, for lack of enabling disclosure.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (2007). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

REVERSED -- 37 C.F.R. § 41.50(b)

rwk

LEE & HAYES PLLC
421 W RIVERSIDE AVENUE SUITE 500
SPOKANE WA 99201